

REMARKS

Summary of the Office Action

Claims 1-6, 8-11, 13-24, 26, and 29-53 stand rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 5,806,072 to Kuba et al.

Claims 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kuba et al. as applied to claim 1 above, and further in view of U.S. Patent No. 6,002,837 to Niida et al.

Claims 12 and 27-28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kuba et al. as applied to claim 10 above and further in view of U.S. Patent No. 5,815,160 to Kikuchi et al.

Claim 25 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kuba et al. as applied to claim 10 above, and further in view of U.S. Patent No. 6,192,191 to Suga et al.

Summary of the Response to the Office Action

Claims 1, 8, 48, and 50 have been amended to describe the invention differently. Claims 2, 49, 52, and 53 have been cancelled without prejudice or disclaimer. Accordingly, claims 1, 3-48, 50, and 51 are presently pending.

All Claims Comply with 35 U.S.C. § 102(a) and § 103(a)

Claims 1-6, 8-11, 13-24, 26, and 29-53 stand rejected under 35 U.S.C. §102(a) as being anticipated by Kuba et al. Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kuba et al. and further in view of Niida et al. Claims 12 and 27-28 stand

rejected under 35 U.S.C. §103(a) as being unpatentable over Kuba et al. and further in view of Kikuchi et al. Claim 25 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kuba et al. and further in view of U.S. Patent No. 6,192,191 to Suga et al. Applicants traverse the rejection for the following reasons.

The present invention relates to an apparatus and method wherein images are recorded and edited directly on a recording medium through use of a scenario file. Specifically, independent claim 1 calls for a scenario file formed by recording a replay order or a replay condition. Independent claim 10 calls for a scenario file stored on the recording medium in which instructions are stored for controlling the display. Independent claim 27 calls for a scenario file for a microprocessor is connected for controlling the display. Independent claim 29 is a method of capturing and editing images wherein a control instruction is stored as a scenario file and the image is modified according to the scenario file. Independent claim 45 recites a scenario file that includes a reproduction start point and a reproduction end point of the moving image data; independent claims 48 and 50, as amended, call for a scenario file that includes at least one of a replaying speed of the image file, a number of repetitions for replaying the image file, a replay range of the image file, a special effect, and a replay of sound associated with the image file, that is stored in the memory.

Applicants respectfully submit that Kuba et al. fails to teach or suggest a scenario file as claimed in the present application. Rather, Kuba et al. relates to an image recorder and file manager of the images recorded. Kuba et al. teaches that once the images are recorded, they can be stored and displayed by date, event, etc. However, Kuba et al. is silent about editing images

once they are recorded according to a separately recorded scenario file. Moreover, while the Office Action states that Kuba et al. teaches a scenario file, the Action fails to specifically point out where in Kuba et al. such a scenario file is taught, but rather obtusely cites to columns 31-32 of the patent.

The other cited references, Niida et al., Kikuchi et al., and Suga et al., either separately or in combination, fail to overcome the deficiencies of Kuba et al. None of these references teach or suggest a scenario file as claimed in independent claims 1, 10, 27, 29, 45, 48, and 50.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(a) should be withdrawn because Kuba et al. does not teach or suggest each feature of independent claims 1, 10, 29, 45, 48, and 50.

Additionally, Applicants respectfully submit that dependent claims 3-9, 11-26, 30-34, 46, 47 and 51 are also allowable insofar as they recite the patentable combinations of features recited in their respective independent claims 1, 10, 29, 45, 48, and 50, as well as reciting additional features that further distinguish over the applied prior art.

Independent claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuba et al. in view of Kikuchi et al. Applicants respectfully traverse the rejection for at least the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

The Office Action has not established a *prima facie* case of obviousness at least because Kuba et al. and Kikuchi et al., whether alone or in combination, fail to teach or suggest all the recited features of independent claim 27. As stated earlier, independent claim 27 calls for a scenario file for a microprocessor is connected for controlling the display. Also as stated earlier, Kuba et al. and Kikuchi et al., whether taken alone or in combination, fail to teach or suggest at least these features of claim 27.

To establish a *prima facie* obviousness, there must be a finding that the prior art included each element claimed. MPEP §2143(A). Because Kuba et al. or Kikuchi et al., whether taken alone or in combination, fail to teach or suggest each feature of independent claim 27, the rejection under 35 U.S.C. § 103(a) should be withdrawn. Furthermore, claim 28 depends from one of independent claim 27. Accordingly, claim 28 is also allowable because of the additional features it recites and the reasons stated above.

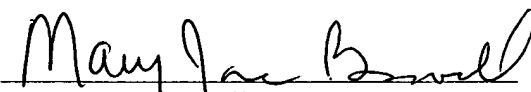
CONCLUSION

In view of the foregoing, Applicants respectfully requests reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicants undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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